

### **DETAILED ACTION**

This Office Action is in response to amendments/arguments filed 2/25/2010. Currently, claims 1-64 are pending in the instant application. Claims 3-5, 10-18, 21-31, 35-42, 46-47, 51-55, 58-64 remain withdrawn from consideration.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/25/2009 has been entered.

#### ***Response to Arguments***

Applicant's arguments filed 2/25/2010 have been fully considered but they are not persuasive. Applicant argues the Klesa does not disclose that the body contacting surface is loosely coupled to human skin to allow ease of movement. Applicant argues the Klesa does not teach this limitation because it is a restraining device. However, Applicant has merely made a conclusive statement and has failed to specify why a restraining device is precluded from being a loosely coupled to the skin. The Klesa device, though it is described as a restraining device, is fully capable of being a vibration dampening device by being wrapped a limb and compressing a tendon to

prevent vibration. Moreover, the Klesa device may be wrapped around the user's limb as loosely as desired by the user, which would inherently include amount where the user may rotate the limb within the device while the device is coupled to the skin of the limb by merely loosely tightening the strap. In addition, Applicant has failed to disclose what object is allowed to be easily moved and what is that object moved relative to. Therefore, the Klesa device still reads on this limitation when the object being moved is construed as a limb and the object being moved relative to is the torso of the user's body.

Applicant arguments, with respect to the reasoning behind the assertions of the rejections of claims 33, 34 and 57 have been addressed in the rejections of those claims below.

***Declaration Under 37 C.F.R. 1.132***

The declaration under 37 CFR 1.132 filed 3/1/2010 is insufficient to overcome the rejection of claims 1-2, 6-9, 19-20, 32-34, 43-45, 48-50 and 56-57 based upon Klesa (U.S. Patent 2,998,008) under 35 U.S.C. 102(b) and U.S.C. 103(a), as well as Klesa (U.S. Patent 2,998,008) in view of Bartlett (U.S. Patent 6,155,999) as set forth in the last Office action because:

It include(s) statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The new claim limitation of "...wherein said body contacting surface is loosely coupled to human skin to allow ease of movement" because Applicant has not disclosed what object is easily moved and relative to what. For the purpose of examination The Office is interpreting the limitation to mean either easy movement of a limb relative to the body contacting service when coupled together, or a limb moving relative to the user's torso when the device is coupled to the limb.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 6-9, 19-20, 43-45, and 48-50 rejected under 35 U.S.C. 102(b) as being anticipated by Klesa (US Patent 2,998,008). Klesa discloses a vibration

dampening device (fig. 1) for engaging human skin (col. 1, lines 7-9), comprising a patch (8) having nominal width, length, and defining an outer periphery (fig. 1); a body contacting surface (1); and a step member (20) engaged to the patch (8). The step member (20) has a distal end (fig. 1) that extends beyond the outer periphery and has freedom to move (fig. 4) with respect to the patch (8). The step member (20) has two ends that extend beyond the outer periphery of the patch (8). The step member (20) is slideably engaged to the patch (8) by threading it through first and second slots (12, 14). A loop (19) is in the central portion of the step member (20). The skin-contacting surface (1) at the central portion is constrained (fig. 2) from moving with respect to the skin to which the patch (8) is engaged. There is an extension (fig. 1) on the distal end of the step member (20), wherein the step member (20) has a length and a center axis along its length.

The Klesa device (fig. 1) may be wrapped around the user's limb as loosely as desired by the user, which would inherently include amount where the user may rotate the limb within the device while the device is coupled to the skin of the limb by merely loosely tightening the step member (20) and not tightening the step member (20) past that point.

With respect to claims 43-45 and 48-50, Klesa discloses all the structural elements of claims 43-45 and 48-50; therefore the method steps would be inherent because they would have resulted from the use of the Klesa device.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 32 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klesa (US Patent 2,998,008) in view of Bartlett (US Patent 6,155,999). Klesa substantially discloses the claimed invention; see rejections to claims 1 and 43 above. Klesa fails to disclose an adhesive for adhering the device to human skin. However, Bartlett teaches a tendon decompression device (10) comprising an adhesive skin-contacting layer (26) to adhere the device (10) to human skin. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the Klesa device with adhesive, as taught by Bartlett, in order to hold the device stationary after application. Moreover, the Klesa/Bartlett device teaches all the structural elements of claim 43, therefore the method steps would be obvious to one of ordinary skill in the art because they would have resulted from the use of the Klesa/Bartlett device.

Claims 33-34 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klesa (US Patent 2,998,008). Klesa substantially discloses the claimed invention; see rejections to claims 1 and 43 above. Klesa fails to disclose the step member (20) is made of a viscoelastic material having a density in the range of 7 to 15 pounds per cubic foot, a tensile strength from 40 to 80 psi, a minimum elongation of 100%, and a compression deflection at 25% of from 3 to 10 psi. However, Applicant has not stated that these parameters solve a stated problem or provide any specific advantage. The Klesa step member would function equally as well as Applicant's step member. Therefore, it would be obvious to one of ordinary skill in the art to make the Klesa step member of the viscoelastic material described by Applicant, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 57, the Klesa device teaches all the structural elements of claim 57, therefore the method steps would be obvious to one of ordinary skill in the art because they would have resulted from the use of the Klesa device.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDON JACKSON whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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